

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

FAMOUS JOE'S PIZZA, INC.,

ECF CASE

Plaintiff,

-against-

Civil Action No.  
10-CV-8861 (JSR)

GIUSEPPE VITALE, an individual,  
JOE'S PIZZA OF BLEECKER ST. INC.,  
JOE'S PIZZA OF BLEECKER ST. 2 LLC,  
JOE'S PIZZA ON SUNSET, INC.,  
and JOHN DOES 1-5,

Defendants.

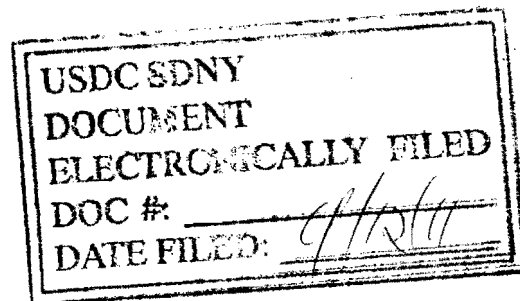
JOE'S PIZZA OF BLEECKER ST. INC., and  
GIUSEPPE VITALE,

Counterclaimants,

-against-

PINO POZZUOLI, an individual,  
FAMOUS JOE'S PIZZA, INC.,  
and JOHN DOES 1-5,

Counterdefendants.



**STIPULATION AND PERMANENT INJUNCTION**

It being so agreed by and between Plaintiff Famous Joe's Pizza, Inc. and Counterclaim Defendant Pino Pozzuoli and Defendants and Counterclaim Plaintiffs Giuseppe Vitale, Joe's Pizza of Bleecker St. Inc., Joe's Pizza of Bleecker St. 2 LLC and Joe's Pizza on Sunset, Inc., it is ORDERED AND ADJUDGED that:

1. This Court has subject matter jurisdiction over this action, as it arises under the Trademark Laws of the United States, specifically the Lanham Act, 15 U.S.C. § 1051, et seq. and the law of the state of New York, and has jurisdiction and venue over the parties.

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**2. Definitions.**

(a) "Vitale" shall mean Giuseppe Vitale, Joe's Pizza of Bleecker St. Inc., Joe's Pizza of Bleecker St. 2 LLC, Joe's Pizza on Sunset, Inc., and their agents, servants, employees, officers, and all persons in active concert and participation with them including but not limited to Muse Pizza, LLC, that operates Joe's Pizza on Hollywood.

(b) "Pozzuoli" shall mean Famous Joe's Pizza, Inc. and Pino Pozzuoli, and their agents, servants, employees, officers, and all persons in active concert and participation with them.

(c) "Script Logo" shall mean the logo shown below:



(d) "Giuseppe Vitale" shall mean Giuseppe Vitale, personally and in his individual capacity.

**3. Permanent Injunction.** In accordance with the Court's order of June 29, 2011, Vitale and their agents, servants, employees, officers, and all persons in active concert and participation with them are hereby permanently enjoined, on pain of contempt, from:

(a) Advertising, promoting, or marketing Vitale's businesses as being associated in any respect whatever with Pozzuoli's business located on Carmine Street;

(b) Using in any way photographs or other photo images of the Pozzuoli's business and storefront on Carmine Street or Pozzuoli's former business and storefront on Bleecker Street in the advertising, promotion, or marketing of any of Vitale's businesses;

(c) Using in any way celebrity photos or other images taken either at the Pozzuoli's business on Carmine Street or Pozzuoli's former business on Bleecker Street in the advertising, promotion, or marketing of Vitale's businesses; and

(d) Advertising, promoting, or marketing Vitale's businesses as being associated in any respect whatever with Bleecker Street or using "Joe's Pizza of Bleecker Street" in the advertising, promotion, or marketing of Vitale's businesses, including but not limited to, removing references to "Bleecker Street" in any corporate name or trade name of Defendants' businesses.

**4. Cancellation of Trademark Registration No. 3,645,485.** U.S. Trademark Registration No. 3,645,485 for JOE'S PIZZA OF BLEECKER STREET is hereby cancelled and the U.S. Patent and Trademark Office ("PTO") is ordered to forthwith cancel the same.

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**5. Use of JOE'S PIZZA / Location of Competing Businesses.**

(a) Pozzuoli shall not file any trademark application to register JOE'S PIZZA in block letters anywhere in the world.

(b) Pozzuoli shall not challenge Vitale's use of JOE'S PIZZA in block letters.

(c) Vitale shall not challenge Pozzuoli's use of JOE'S PIZZA in block letters.

(d) Vitale shall not file any trademark application to register JOE'S PIZZA in block letters anywhere in the world.

(e) Giuseppe Vitale may use JOE'S PIZZA anywhere in the world, however, Giuseppe Vitale and any entity that he has an interest in, either directly or indirectly, and his agents, servants, employees, officers, and all persons in active concert and participation with him shall not use the name or mark JOE'S PIZZA in New York State. Giuseppe Vitale and any entity that he has an interest in, either directly or indirectly, and his agents, servants, employees, officers, and all persons in active concert and participation with him shall not hold an interest in or open any restaurants serving pizza in New York State under any name.

(f) Pozzuoli agrees that Pozzuoli shall not open or license the opening of a restaurant serving pizza within a 2.5 (two and one half) mile radius of the restaurant now located at 111 Broadway at Ocean Ave, Santa Monica, California; and a 1 (one) mile radius of the restaurants now located at 8539 Sunset Blvd, West Hollywood, California and at 6504 Hollywood Blvd, Hollywood, California under the name JOE'S PIZZA, but such restrictions shall not be applicable if the restaurants now respectively located at the specified locations close or relocate or operate under a name different than JOE'S PIZZA.

**6. Use of the Script Logo.**

(a) Vitale shall not use the Script Logo or any part thereof in any manner unless specifically permitted in this Stipulation and Permanent Injunction and shall not use the Script Logo in New York State. Except as otherwise restricted herein and in subparagraph 5(e) above, if Giuseppe Vitale, alone or together with his sons Pino Vitale and/or Salvatore Vitale, own at least 50% of a restaurant serving pizza, and otherwise complies with this Stipulation and Permanent Injunction, Giuseppe Vitale may use the Script Logo in connection with the advertising, promoting, or marketing of that restaurant serving pizza. Giuseppe Vitale shall not franchise restaurants serving pizza that use the Script Logo. Giuseppe Vitale shall not grant the right to use the Script Logo outside of New York State to any person or entity who has an interest, directly or indirectly, in a restaurant serving pizza in New York State which operates as a JOE'S PIZZA, and any such right that Giuseppe Vitale may grant that person or entity shall

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restrict such person or entity from opening a restaurant serving pizza in New York State under the name JOE'S PIZZA.

(b) If Giuseppe Vitale uses the Script Logo as permitted in subparagraph 6(a) above, he shall not use the tagline or slogan "A SLICE OF HISTORY", "A SLICE OF NYC" or "A SLICE OF MANHATTAN" in connection with a restaurant serving pizza.

(c) Pozzuoli shall have the exclusive right to use the Script Logo in New York State and the right to use the Script Logo anywhere in the world in any manner. Nothing in this Stipulation and Permanent Injunction shall prevent Pozzuoli from filing an application to register the Script Logo in its name as owner of the mark. In the event a trademark registration or application owned by Vitale is cited against an application filed by Pozzuoli for the Script Logo, Vitale shall consent to the registration of Pozzuoli's application. Nothing herein shall prevent Vitale from filing an application to register a new script format as provided in paragraph 7 below.

(d) Vitale acknowledges Pozzuoli's ownership of the Script Logo and the validity and enforceability of the Script Logo and shall not take any action adverse to those rights. Vitale shall not directly or indirectly challenge Pozzuoli's rights to the Script Logo or any application filed by Pozzuoli for the Script Logo.

**7. Vitale's New Script Format.**

(a) Within thirty (30) days of the entry of this Stipulation and Permanent Injunction by the parties, Vitale shall file a new trademark application for JOE'S PIZZA in a new script format with the PTO, which new script format is not confusingly similar to the Script Logo. Provided Pozzuoli agrees that the new script format is not likely to cause confusion with the Script Logo, Pozzuoli shall not object to Vitale's use of the new script format or any trademark application based on the new script format.

(b) In the event that the PTO cites a trademark registration or application owned by Pozzuoli against an application filed by Vitale for the new script format, Pozzuoli shall consent to the registration of the new script format. Pozzuoli shall not be required to consent to the registration of the new script format in the event that the PTO finds that the new script format is likely to cause confusion with the Script Logo.

**8. Photographs.** Vitale may publicize (online or otherwise) or hang in its existing restaurants and in any new restaurants photographs or videos taken at its existing or any new restaurants showing Giuseppe Vitale or other employees together with celebrity patrons, provided any such photographs or videos specifically redact any image or material which would violate this Stipulation and Permanent Injunction such as but not limited to the words "of Bleecker Street."

**9. Trademark Registration No. 3,508,216 of the mark JOE'S PIZZA (block letters).** Within thirty (30) days of the issuance of a Notice of Allowance for the application for Vitale's new script format, or within thirty (30) days of the PTO's final refusal to register Vitale's new script format, whichever is sooner, Vitale shall surrender



Trademark Registration No. 3,508,216 to the PTO. Notwithstanding the foregoing, Vitale shall surrender Trademark Registration No. 3,508,216 to the PTO no later than one (1) year from the entry of this Stipulation and Permanent Injunction. Vitale shall transmit a copy of the surrender documents to counsel for Pozzuoli.

**10. Trademark Application Serial No. 85/220,303 of the Script Logo.**

Vitale shall file with the PTO an express abandonment of U.S. Trademark Application Serial No. 85/220,303 with prejudice within five (5) days of the entry of this Stipulation and Permanent Injunction, and shall transmit a copy of the express abandonment to counsel for Pozzuoli.

**11. Release of Bond.** Plaintiff having posted a bond on December 14, 2010 in the amount of five thousand dollars (\$5,000) in the form of a check in connection with the Court's orders of December 10, 2010 and December 23, 2010, and the parties having resolved the dispute between them, it is, for good cause shown, **ORDERED** that the same is hereby discharged and terminated and that the Clerk of the Court return five thousand dollars (\$5,000) to Famous Joe's Pizza, Inc. in the form of a check.

**12. Notices.** Any notice, demand, or request required or permitted to be given under this Stipulation and Permanent Injunction shall be in writing and shall be deemed given when: (a) delivered personally (in which case notice effective upon delivery); (b) sent via registered or certified mail, return receipt requested (in which case notice is effective the fifth business day after mailing); or (c) sent via overnight courier (in which case notice is effective on the next business day after deposit); and addressed to the party at the address below or such other address as such party may request by notifying the other party in writing.

To Famous Joe's Pizza, Inc.  
or Pino Pozzuoli:

Maria A. Savio, Esq.  
Marc P. Misthal, Esq.  
Gottlieb, Rackman & Reisman, P.C.  
270 Madison Avenue  
New York, New York 10016

To Giuseppe Vitale;  
Joe's Pizza of Bleecker St. Inc.;  
Joe's Pizza of Bleecker St. 2 LLC;  
and/or Joe's Pizza on Sunset, Inc.:

William H. Hochberg, Esq.  
Law Offices of William Hochberg, P.C.  
201 Santa Monica Blvd., Suite 300  
Santa Monica, California 90401

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**13. Governing Law.** This Stipulation and Permanent Injunction, including issues relating to its validity and the rights and duties of the parties, shall be construed and enforced pursuant to the laws of the State of New York, excluding its conflict of laws rules to the extent such rules would apply the law of another jurisdiction.

**14. Termination of Civil Action.**

The parties have agreed to the entry of this Stipulation and Permanent Injunction so as to amicably resolve their respective claims and counterclaims and neither party admits to any liability or wrongdoing. Subject to continuing compliance with this Stipulation and Permanent Injunction, the parties hereby dismiss, with prejudice, their respective remaining claims and counterclaims in their entirety. Each party will bear its own costs and legal fees.


**15. Continuing Jurisdiction.** The Court shall retain jurisdiction to enforce the provisions of this Stipulation and Permanent Injunction.

IN WITNESS WHEREOF, the parties have executed this Stipulation and Permanent Injunction on the dates set forth below.

DATE: 9-7-2011

By:   
GIUSEPPE VITALE

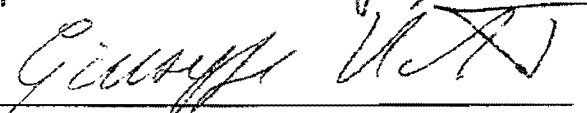
DATE: 9-7-2011

By:   
JOE'S PIZZA OF BLEECKER ST. INC. by  
GIUSEPPE VITALE, its PRESIDENT

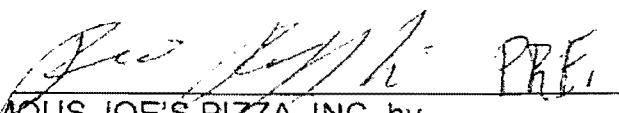
DATE: 9-7-2011

By:   
JOE'S PIZZA OF BLEECKER ST. 2 LLC by  
GIUSEPPE VITALE, its MANAGER/OWNER

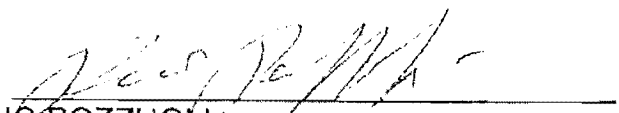
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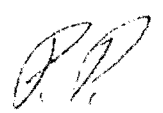
By:   
JOE'S PIZZA ON SUNSET, INC. by  
GIUSEPPE VITALE, its PRESIDENT

DATE: 9-8-2011

By:  PRE.  
FAMOUS JOE'S PIZZA, INC. by  
PINO POZZUOLI, its President

DATE: 9-8-2011

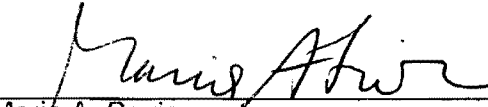
By:   
PINO POZZUOLI



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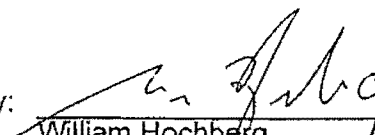
DATED: September 8, 2011

GOTTLIEB RACKMAN & REISMAN, P.C.

By:   
Maria A. Savio  
Marc P. Mithal  
Attorneys for Plaintiff and Counter-Claim  
Defendant Famous Joe's Pizza, Inc. and  
Counter-Claim Defendant Pino Pozzuoli

DATED: September 8, 2010

LAW OFFICES OF WILLIAM HOCHBERG, P.C.

By:   
William Hochberg  
Attorneys for Defendants and Counterclaim  
Plaintiffs Giuseppe Vitale, Joe's Pizza of  
Bleecker St. Inc., and Defendants Joe's  
Pizza of Bleecker St. 2 LLC and Joe's Pizza  
on Sunset, Inc.,

SO ORDERED:

DATE: 9/8/11

  
U.S.D.J.